

P₁ (c) a window pane for closing off the window opening formed by the spigot, and

P₁ (d) means hingedly connecting said window pane to said mounting flange,

P₁ (e) said sill of the spigot having a portion which is downwardly offset with respect to remaining areas of the sill, said downwardly offset portion being provided with a sloping [, upwardly-open] drain groove extending from a high location closely adjacent said mounting flange to a low location disposed remote from the mounting flange [.]

P₁ (f) said drain groove being open at the top for a substantial portion of its length, thereby defining an open channel which resists the tendency for residue to form therein and cause possible clogging.

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Concl. d

Add the following claims:

~~Claim 12~~² The invention as defined in claim 1, wherein:

P₁ (a) said sill has a portion which is sloped with respect to the plane of the window, in order to provide for drainage of water in a direction away from the window pane.

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~~Claim 13~~³ The invention as defined in claim ~~12~~², wherein:

P₁ (a) said drain groove has a portion whose slope exceeds the slope of the sill, thereby to collect drainage from the latter and channel it away from the window pane.

REMARKS

In a separate letter to the Official Draftsman, directions for correction of the drawings, Fig. 4, are given. These changes are in accordance with the recommendations of the Examiner as set forth in the second paragraph of the Official Action.

Applicant submits herewith a fresh copy of the Abstract, on a separate page. Cancellation of the original

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Abstract is hereby authorized.

The specification has been amended on page 8, line 15 in order to clarify the terminology. As now recited, the screen has a peripheral frame 78 which can be considered to be the portion of the screen that is of relatively flat, rectangular configuration, and a flange 80 which is integral with the frame, and is the part which fits into the groove 82, this part being of generally square cross section in Fig. 4.

In addition, a statement explaining the term "downwardly offset" has been included in the specification, page 10, line 18. It is believed that the phrase "downwardly offset" is correct in view of the showing of Fig. 2, wherein the parts labelled 96 and 100 extend below adjacent areas of the sill 90.

With respect to claim 8, in the specification, page 9 lines 14-19 state that the groove 82 communicates with the wall 104 of the groove 98 so as to provide for drainage of water from the groove 82. It is believed that the recitations are correct. In support of this, one can determine from Fig. 5, that if the screen (flange 80) were removed, the area indicated 82 would be space, as would the area indicated 104. These spaces would overlap, that is, there would be communication between them in order to permit water to flow from the space 82 into the groove (wall 104). If it is still believed that the present disclosure is not correct, an opportunity to discuss the matter with the Examiner would be appreciated.

Claim 1 has been amended in order to more clearly and accurately define the invention, as well as to more particularly

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distinguish over the prior art.

As now amended and presented, claim 1 sets forth a novel concept and defines structure which are clearly neither disclosed nor even remotely suggested in the prior art citations, particularly the Beckerer and Greenfield patents.

Considering first the novel concept of the claim which is not found in the prior art, this embraces a self-draining, leak-resistant boat window having a spigot with an upwardly-facing drain surface constituting a sill, wherein the sill has a portion which is downwardly offset with respect to remaining areas of the sill, thus providing a drain groove which is open along its top for a substantial portion of its length. The groove thus constitutes an accessible channel which resists the tendency for residue to form therein and cause possible clogging.

The above concept involving a downwardly offset portion of a boat window sill, providing a channel or groove which is open at its top, is neither shown nor suggested in Beckerer or Greenfield. The Beckerer patent discloses only a sill (90), but no downwardly offset portions. Greenfield involves closed drain passages (78) which are beneath the sill of the spigot.

Not only is the applicant's concept not disclosed, but in addition the construction of the present application is seen to have important advantages which are not enjoyed by the devices of the prior art. In the section of the present application entitled "Background", attention is directed to page 2, bottom 3 lines, and page 3, lines 1-5. Also, page 10, last 6 lines, and page 11, lines 1-5. In summary, it has been found that with drain constructions involving closed passages, clogging of such passages is likely to occur. Freeing of such passages is sometimes difficult, particularly in view of the

fact that the passages are accessible from only the outside of the boat hull.

The present invention effectively overcomes this problem of clogging, by providing upwardly open channels which tend to be free-flushing. Due to the fact that they are exposed and readily accessible, it is a relatively easy matter to clean out the groove should the need ever arise.

Considering now the novel structure of the claim which is not found in the prior art, there is specified that the sill of the spigot has a portion which is downwardly offset with respect to remaining areas of the sill, said downwardly offset portion being provided with a sloping drain groove, said drain groove being open at its top along a substantial portion of its length, thereby defining an open channel which resists the tendency for residue to form therein and cause possible clogging. The above structure involving an upwardly-open drain groove is neither shown nor suggested in Beckerer or Greenfield.

Dependent claims 2-11 add further details and limitations to the novel structure of claim 1 as now amended.

New claims 12 and 13 are also presented, in order to cover further aspects of the applicant's inventive concept. Claim 12 adds, to the combination of claim 1, that a portion of the sill is sloped with respect to the plane (normal) of the window. Claim 13 recites that the drain groove has one section which is sloped by an amount in excess of the sloping of the sill, thereby permitting drainage from the latter, and flow of water in a direction away from the window pane.

Charge cost of claims 12 and 13 to Deposit Account No. 12-1020.

It is respectfully pointed out that no one reference

discloses either the concepts or the structures of claims 1-13 as now presented. Moreover, there is no teaching in any of the references that a first part of one patent should be combined with a second part of another, and so on, in order to produce an anticipation. One taking the position that it is obvious to combine certain features of the prior art devices is, in an unwarranted manner, bridging a substantial gap which exists in the prior art of record.

Detailed below are excerpts from case law decisions, setting forth conclusions of various tribunals as handed down in analogous situations. These excerpts are considered to be especially pertinent to the matters in issue in the present application.

A tabulation of the decisions from which excerpts are quoted in the following pages, is given here for the convenience of the Examiner:

1. Morril v. Automatic Industries, Inc. (DC W Mo) 87 USPQ 70
2. Lincoln Stores v. Nashua Mfg. Co. (CCA 1) 70 USPQ 254
3. Robertson Rock Bit Co., v. Hughes Tool Co.
(CA 5) 82 USPQ 339
4. ex parte Flynn and Ingersol 59 USPQ 116 POBA
5. Pointer v. Six Wheel Corp. 177F (2) 153
6. Topliff v. Topliff 145 U. S. 156
7. In re Bisley 94 USPQ 86 (CCPA)
8. General Electric Co. v. Hartman 187 Fed. 131 CCPA
9. Parks v. Booth 102 U. S. 96 at 104
10. Safety Car Heating and Lighting Co. v. General Electric Co. 155 F (2) 937
11. Loom v. Higgins 105 U. S. 580
12. Reiner v. I. Leon Co., 285 F (2) 501,503; 128 USPQ 25
(2d Cir. 1960)

While one might consider the review of case law as not being especially productive, it must be remembered that the matter of patentability and infringement as decided in present day issues is essentially the result of all that has gone before, condensed and crystallized into practical and workable guidelines.

In considering the foregoing paragraphs the Examiner should especially note that one having no knowledge of the present disclosure would be at a loss to produce the invention defined by the claims merely from a consideration of the references, without the exercise of the creative or inventive faculties.

It has been held in the past that different structures from prior patents cannot properly be modified in the light of an applicant's disclosure, to constitute an anticipation. This type of mozaic process which seeks to anticipate a claim is considered to be not well founded but instead untenable.

A decision which shows the impropriety of reading into prior patents the teachings of an applicant is as follows:

Morril v. Automatic Industries, Inc. (DC W Mo) 87 USPQ 70:
here there was stated:

"In determining similarities and differences in devices, as affecting validity of patent, court should look at devices in light of what they do, or what function they perform, and how they perform; that prior device may be easily changed to produce result of subsequent device does not show anticipation."

It is also pointed out that the present combination is new, and that no one patent discloses this combination. In the past it has been held that such a situation is indicative of patentability as shown by the following two decisions:

In Lincoln Stores v. Nashua Mfg. Co. (CCA 1) 70 USPQ 254
there was stated:

"Where no prior art patent discloses all elements of patent in suit, they cannot be combined for that purpose."

In Robertson Rock Bit Co., Inc. v. Hughes Tool Co. (CA 5) 82 USPQ 339 there was stated:

"It will not do to cull elements of combination in suit from different prior patents; defendant must show not that some elements are present in prior patents, but that combination is present."

It is seen that an applicant's entire combination must be disclosed in the prior art. The citations fail in this respect.

Considering the matter of conception, it is believed that any determination of patentability must take into account the absence or presence of the inventive idea in the prior art. In this connection the decision of ex parte Flynn and Ingersol 59 USPQ 116 POBA is in point. Here the Court stated:

"It is possible as an academic matter to change one thing into another but from a legal viewpoint there must be somewhere in the record a suggestion of applicants' inventive concept and there is no such disclosure here except in applicants' specification. Obviously applicants' own disclosure in their specification cannot be used as prior art nor can the Examiner rely on a holding of lack of invention when the structure has various advantages as described and which are not obvious."

In Pointer v. Six Wheel Corp. 177 F (2) 153, the Court stated:

"The question is: Did anyone before think of combining them in this manner to achieve the particular unitary result, - a new function? If not, there is invention. At times, the result is accomplished by means which seem simple afterwards. But, although the improvement be slight, there is invention, unless the means were plainly indicated by the prior art. Paraffine Companies v. McEverlast, Inc. 84 F (2) 335, 341."

In Topliff v. Topliff, 145 U.S. 156 there was stated:

"It is not sufficient to constitute an anticipation that the device relied upon might, by modification, be made to accomplish the function performed by the patent in question, if it were not designed by its maker, nor adapted, nor actually used, for the performance of such functions."

The above decisions all indicate that consideration must be given to the conception of an idea, when determining the matter of patentability. The concept of the present invention as outlined above is seen to be lacking in the art.

The fact that an applicant's contribution is simple does not mean that invention is absent. In support of this, there is cited herewith the decision of In re Bisley, 94 USPQ 86 (CCPA) where the Court held as follows:

"Counsel for appellant in his brief contends that in a case like this, invention is to be gauged not alone by the extent or simplicity of the physical changes made, but also by the perception of the necessity or desirability of making such changes to produce a new result. We think that this contention has merit. When viewed after disclosure by appellant, these changes seem simple and such as should have been obvious to those in the field. However, this does not necessarily negative invention or patentability."

It is considered that the applicant's combination as now claimed is clearly not obvious, and further noted that it involves a new mode of operation in a boat window, by which water can drain freely into downwardly offset channels in the sill of the window, with the channels being open at their tops so that the tendency for clogging of the channels to occur is greatly minimized, and wherein cleaning out of the channels can be readily effected.

On the matter of obviousness, the decision of General Electric Co. v. Hartman 187 Fed. 131 CCPA is pertinent. Here the Court stated:

"After a thing of this kind is accomplished, the point of view makes it seem a simple contrivance, but, in dealing with the question of invention, the essential view is from the state of the art existing at the time the necessary problem was sought to be solved."

"If a skilled mechanic were given the conception and the idea, it is possible that he might work out a result, but that, it would seem, is not the correct point of view. We must look at the situation as it existed prior to the conception which suggested or promoted the beneficial mechanical arrangement."

Along these lines is also the decision of Parks v. Booth, 102 U. S. 96 at 104 where the Court stated:

"Where the thing patented is an entirety, consisting of a separate device or of a single combination of old elements incapable of division or separate use, the respondent cannot make good the defence in question by proving that a part of the entire invention is found in one prior patent, printed publication or machine, and another part in another, and so on indefinitely, and from the whole or any given number expect the Court to determine the issue of novelty adversely to the complainant. Bates v. Coe, 98 U. S. 31."

"Common justice forbids such a defence, as it would work a virtual repeal of so much of the Patent Act as gives to inventors the right to a patent consisting of old elements, where the combination itself is new and produces a new and useful result. New elements in such a patent are not required, and if such a defence were allowed, not one patent of the kind in a thousand of modern date could be held valid. Nor is such a defence consistent with the regulations enacted by Congress in respect to the procedure in litigations in respect to the patent rights."

The Parks v. Booth decision supra clearly indicates that a new combination of elements may yet be patentable even though these elements are found in various citations of the prior art.

It must be realized that the mere existence of various elements in the prior cited art does not mean that a new and unique combination of these elements, producing an advantageous and improved result, is not patentable. For, in the decision of Safety Car Heating and Lighting Co. v. General Electric Co. 155 F 2, 937 the Court stated:

"In appraising an inventor's contribution to the art as we have often said, the most reliable test is to look at the situation before and after it appears. Substantially all inventions are for the combination of old elements; what counts is the selection out of all of their possible permutations, of that new combination which will be serviceable. No objective standard is practicable."

Thus, any consideration of patentability must go beyond the existence of individual elements in the prior art.

Regarding the matter of an applicant's combination being absent from the prior art, the Parks v. Booth decision above also stated as follows:

"Most or all of the inventions described in those publications (prior patents) bear more or less resemblance to that claimed by the complainant, (infringed patentee), and it may be that if it were allowable to test the validity of the invention in question by comparing the same with the whole (prior art) as if embodied in a single exhibit, the

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evidence might be sufficient to support the views of the respondents (infringers who argue validity) in respect to the defence under consideration. Were that allowable it might well be suggested that the screen is found in one, the box in another, and the means to produce the lateral shake in a third, and so on to the end; but it would still be true that neither the same combination in its entirety nor the same mode of operation is described in any of the patents or printed publications given in evidence."

If one skilled in the art were confronted with the citations relied on, it is highly improbable that such person would conceive the idea embraced by the present invention, as set forth in the claims. It is respectfully requested that the Examiner place himself in the position of one having no knowledge of the present disclosure. Such a person could consider all aspects of the expressed teachings of the references without once arriving at the invention as claimed.

It is believed that the citations made by the Examiner are clearly deficient as an anticipation, because they do not disclose all of the claimed elements, functioning in the same way. In this connection the Examiner is referred to the decision of *Lincoln Stores v. Nashua*, 70 USPQ 254 where there was stated:

"The prior art will not anticipate a patent for a combination unless it discloses all the elements of such combination or their mechanical equivalents, functioning in substantially the same way to produce substantially the same result; and a prior patent does not anticipate a subsequent patent where the prior patent failed to solve the problem which the subsequent patent solves successfully."

"But the fact that a new combination of old elements produces a new and beneficial result, hitherto unattained, merits consideration as evidence of invention. *Webster Loom Co. v. Higgins* 105 U.S. 580. And a substitution which involves a new mode of construction, or develops new uses and properties of the article formed, may amount to invention. *Smith v. Goodyear Dental Vulcanite Co.* 93 U.S. at page 492. A patentable combination may be comprised of elements that are all old, or all new, or partly old and partly new."

On the matter of obviousness, it is understood that all sorts of boat windows have been proposed and produced, going back a considerable number of years. If the applicant's improved boat window construction were obvious, surely one skilled in the art would have evolved the improvement before the present application. It has been recognized in the past that if an improvement is obvious, then a considerable length of time would not elapse before it was made known. This was clearly set forth in the decision of *In re Shortell* 142 F2 CCPA: 61 PQ 362.

"Mere consideration of prior patent would lead to conclusion the improvement was obvious to one skilled in the art, but because 60 years elapsed without such improvement, court (CCPA) concluded that it was not obvious."

"If this improvement was obvious to one skilled in the art, as held by the Patent Office tribunals, it seems to us that 60 years would not have elapsed before it was made. --we do attach importance to the fact that applicant's improvement was regarded by manufacturers who use hacksaws, and by dealers in them, as an important discovery."

Another decision in point is that of *Loom v. Higgins*, 105

U. S. 580, where the Supreme Court said (page 591):

"But it is plain from the evidence, and from the very fact that it was not sooner adopted and used, that it did not, for years, occur in this light to even the most skillful persons. It may have been under their very eyes, they may almost be said to have stumbled over it; ***Now that it has succeeded, it may seem very plain to any one that he could have done it as well. This is often the case with the inventions of the greatest merit."

Judge Learned Hand, in *Reiner v. I. Leon Co.*, 285 F 2d 501, 503, 128 USPQ 25 (2d Cir. 1960), expressed a point of view which appears to be relevant on the matter of obviousness. He stated:

"It is idle to say that combinations of old elements cannot be inventions; substantially every invention is for such a 'combination'; that is to say, it consists of former elements in a new assemblage."

"The test laid down is indeed misty enough. It directs us to surmise what was the range of ingenuity of a person having 'ordinary skill' in the 'art' with which we are totally unfamiliar; and we do not see how such a standard can be applied at all except by recourse to the earlier work in the art, and to the general means available at the time. To judge on our own that this or that new assemblage of old factors was, or was not, 'obvious' is to substitute our ignorance for the acquaintance with the subject of those who are familiar with it. There are indeed some sign posts; e.g. how long did the need exist; how many tried to find the way; how long did the surrounding and accessory arts disclose the means***?"

Judge Hand took cognizance of the length of time that the need existed, and the fact that many tried to find the way, as well as how long the surrounding and accessory arts disclosed the separate means for elements.

In the present instance, the need may have existed for an appreciable time, and the means or individual elements may have existed in the surrounding and accessory arts. It is impossible to say how many tried to find the way, but it appears that no one did, prior to this application. Accordingly, this would also tend to indicate that the present invention is clearly not obvious in the light of 35 USC 103.

In conclusion, it is pointed out that the prior art lacks both the concept and the defined inventions of the claims as now amended and/or presented. The organization provided is considered to be clearly not obvious, representing an advance and improvement over the prior devices in the art. Its simplicity does not negative patentability. The concept is surprisingly new, although seemingly simple after being revealed. Not even a remote suggestion of the specific organization set forth in the claims is found in the cited prior devices and patents.

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Accordingly, allowance of the claims and of the application are respectfully requested.

In the event that this application is considered to be not in allowable condition, an opportunity to discuss the matter with the Examiner will be appreciated. The telephone number of the agent of record is 1-203-372-7695.

Respectfully submitted,
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by 
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SELF-DRAINING BOAT WINDOW

Abstract of the Disclosure

A self-draining, leak resistant boat window comprising a frame body having a continuous mounting flange for engagement with an inner surface surrounding an opening in the boat hull. The body has a spigot which is connected with the mounting flange. A low portion of the spigot has an upwardly facing drain surface constituting a sill. The sill has a downwardly offset portion provided with a sloping, upwardly-open drain groove which extends from a high location adjacent the mounting flange to a low location, remote from the mounting flange. The arrangement is such that water which is splashed onto the sill is channeled toward the offset portion, and thereby drained away. There is thus minimized the tendency for water to collect on the sill and leak into the boat interior when the window pane is opened.

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Fig. 5 Fig. 6 Fig. 7

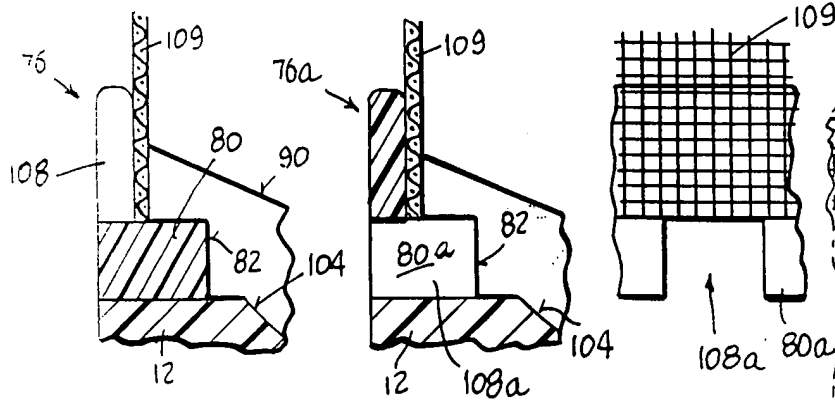


Fig. 4

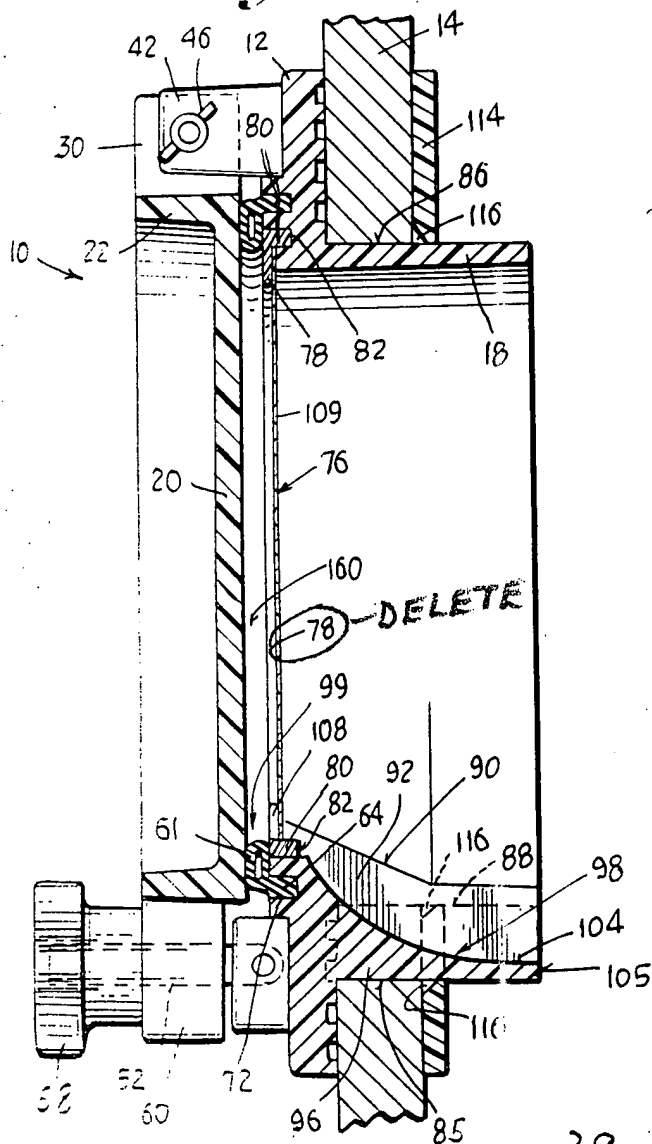


Fig. 3

